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02 APR 2007

In re Application of
Kogel et al.
Application No.: 10/522,106
PCT No.: PCT/EP03/07589
Int. Filing Date: 14 July 2003
Priority Date: 22 July 2002
Attorney Docket No.: 12810-00067-US
For: Method For Obtaining Pathogenic
Resistance In Plants

DECISION

This is in response to the "Request For Reconsideration" filed on 20 November 2006.

DISCUSSION

In a Decision mailed on 02 October 2006, the petition for withdrawal of the holding of abandonment and the request for withdrawal as attorney or agent filed 25 February 2005 was treated as follows:

With regard to the Request For Withdrawal As Attorney Or Agent filed on 25 February 2005, counsel's attention is drawn respectfully to MPEP 402.06, which states in part that

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the Technology Center Director where the application is assigned where appropriate procedure will be followed pertaining to the withdrawal. The **withdrawal is effective when approved** rather than when received.

Since the approval by the Director of the withdrawal was not given prior to the mailing of the Form PCT/DO/EO/922, that form was properly mailed to the pre-existing correspondence address of record.

With regard to the Transmittal of Power of Attorney, and attached Power of Attorney, Statement Under 37 CFR 3.73(b), Assignment and Recordation Form Cover Sheet filed by present counsel on 03 June 2005, inspection of the included "Assignment of Application" reveals that it does not specifically identify the application which is being assigned. Therefore, the 03 June 2005 submission did not properly establish the right of the assignee to take action in this case, and so the submission was not effective in changing the pre-existing correspondence address of record.

Since the Form PCT/DO/EO/922 was properly mailed to the correct correspondence of record, the petition to withdraw the holding of abandonment is **DISMISSED**, without prejudice.

In the same Decision, the petition under 37 CFR 1.137(b) was dismissed without prejudice because

Regarding requirement (1), the required reply in this case is the reply required by the Form PCT/DO/EO/922 mailed on 01 July 2005 - specifically, a substitute computer readable form (CRF) of the sequence listing and a statement that the content of the CRF is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter. Since applicants have not filed such a response, requirement (1) has not been met.

Petition To Withdraw Holding Of Abandonment

Petitioner, requesting reconsideration of the petition to withdraw the holding of abandonment, argues that "on the initial filing date of the application which included the 'Assignment of Application' with the proper cover sheet, it would have been impossible for the U.S. application number to be indicated," and that "at the time of filing of the U.S. national stage application on January 24, 2005, the 'Assignment of Application' was already executed and could not have specifically identified the application by its U.S. application number." Petitioner further urges that the Assignment was identified by an internal docket number, 0000053764, and that "the submission of the Power of Attorney and change of correspondence address was not to establish the rights of the assignee, since these were already established with the initial filing of the application, but to appoint new attorneys and change the correspondence address."

Petitioner's attention is respectfully drawn to 37 CFR 3.21, which provides that

37 CFR 3.21 Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (*e.g.*, PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

And to MPEP 302.03, which states that

The patent or patent application to which an assignment relates must be identified by patent number or application number unless the assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed. Then, the application must be identified by ** the name(s) of the inventors, and the title of the invention. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name(s) of the inventors and the title of the invention.

The Office makes every effort to provide applicants with the application numbers for newly filed patent applications as soon as possible. It is suggested, however, that an assignment be written to allow entry of the identifying number after the execution of the assignment. An example of acceptable wording is:

"I hereby authorize and request my attorney, (Insert name), of (Insert address), to insert here in parentheses (Application number , filed) the filing date and application number of said application when known."

Inspection of the "Assignment of Application" filed on 03 June 2005 reveals that said assignment does "identify the patent application by the name of each inventor," but that it does not identify the application by the title. Rather, the space for the title has been left blank. 37 CFR 3.21 does not provide for this defect to be overcome by the provision of an identifying number (e.g., docket number) in place of the title. In view of 37 CFR 3.21 and MPEP 302.03, it therefore would not be appropriate to accept the "Assignment of Application" filed on 03 June 2005 for purposes of establishing the ownership of the application by BASF Plant Science GmbH in order to take action in the application pursuant to 37 CFR 3.73(b).

Petitioner observes that the "Assignment of Application" was recorded in the USPTO on 24 January 2005 at Reel/Frame No. 016749/0176. However, the reel and frame information was not furnished on the 37 CFR 3.73(b) statement filed on 03 June 2005; rather, the location provided for this information to be recorded on the form was left blank. Since the 37 CFR 3.73(b) statement neither referred to the reel/frame number where the assignment was recorded nor was accompanied by a copy of an assignment properly identifying the application to which it was directed, the submission of 03 June 2005 was not effective in changing the correspondence address of record. Consequently, the Notification To Comply... (Form PCT/DO/EO/922) mailed on 01 July 2005 was properly addressed to previous counsel of record. Accordingly, it would not be appropriate to withdraw the holding of abandonment on the basis of the present record.

Petition Under 37 CFR 1.137(b)

As noted supra, the previous petition under 37 CFR 1.137(b) was not accompanied by the required reply (in the form of a substitute computer readable form (CRF) of the sequence listing and a statement that the content of the CRF is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter had not been filed. Review of the record reveals that an acceptable CRF was entered into the USPTO database on 12 December 2006, and that the 20 November 2006 submission further included statements that the content of the CRF is identical to the written (on paper or compact disc) sequence listing and includes no new matter. As such, the requirements of 37 CFR 1.137(b) have now been satisfied.

It is noted that the declaration of the inventors filed on 24 January 2005 is defective in that it includes an un-initialed alteration. Specifically, the date of Mr. Kogel's signature has been covered and re-entered, without the alteration being initialed by Mr. Kogel.

CONCLUSION

The petition to withdraw the holding of abandonment is **DISMISSED**, without prejudice.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b).



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